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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,897	11/28/2003	David Samuel Griswold		2891

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EXAMINER	
TOMASZEWSKI, MICHAEL	
ART UNIT	**PAPER NUMBER**
3626	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/722,897	GRISWOLD, DAVID SAMUEL	
	Examiner	Art Unit	
	Mike Tomaszewski	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 28 November 2003. Claim 1 is pending. No IDS statements have been received, entered or considered.

Specification

2. The disclosure is objected to because of the following informalities: claims drafted improperly. Appropriate correction is required.

(A) Claim elements and/or steps are not separated by a line indentation. See 37 CFR 1.75 and MPEP § 608.01(m). See also Content of Specification, (j) Claim or Claims, infra.

Content of Specification

(a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

(b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

(c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.

(d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).

(e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

(f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

(2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

(g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the

Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

(i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

(k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

(l) Sequence Listing, See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed

in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Objections

3. Claims are objected to because of the following informalities: drafted improperly. Appropriate correction is required.

(A) The claim is not numbered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(A) Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a

manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud (5,845,255; hereinafter Mayaud), in view of Joao (6,283,761; hereinafter Joao).

(A) As per claim 1, Mayaud discloses:

(b) prior to using the clearinghouse, the physician must register with the clearinghouse. Once registered, the physician may create prescriptions using any web browser and then send those prescriptions over the Internet to any pharmacy registered with the clearinghouse. The clearinghouse will save every prescription in its database. This allows a

physician to search this prescription database for historical purposes or to modify and reissue prescriptions created by that physician (Mayaud: abstract; col. 10, lines 10-66; col. 19, lines 3-67; col. 20, lines 1-67; col. 25, lines 35-67; col. 26, lines 1-67; col. 27, lines 1-50; Fig. 1-21).

(c) prior to using the clearinghouse, the pharmacy must register with the clearinghouse. Once registered, the pharmacy can receive prescriptions from the clearinghouse. The clearinghouse will deliver prescriptions in an industry standard or pharmacy defined format. The pharmacy will receive prescriptions electronically over the Internet from the clearinghouse. This will allow the pharmacy to automatically update its computer systems and route the prescription to the specific retail pharmacy. The clearinghouse will also allow the pharmacy to e-mail questions regarding a specific prescription back to the physician that issued the prescription (Mayaud: abstract; col. 10, lines 10-66; col. 19, lines 3-67; col. 20, lines 1-67; col. 25, lines 35-67; col. 26, lines 1-67; col. 27, lines 1-50; Fig. 1-21).

(d) prior to accessing the clearinghouse, the patient must register with the clearinghouse. Once registered, the patient can access the clearinghouse and view the specific prescription history. If a specific prescription has open refills the patient can request the clearinghouse send that prescription to the pharmacy requesting the prescription be refilled. The

clearinghouse will notify the physician that the patient has requested a refill if necessary (Mayaud: abstract; col. 10, lines 10-66; col. 19, lines 3-67; col. 20, lines 1-67; col. 25, lines 35-67; col. 26, lines 1-67; col. 27, lines 1-50; Fig. 1-21).

Mayaud, however, fails to expressly disclose:

(a) the creation of a publicly accessible Internet-based electronic clearinghouse that processes prescriptions for drugs. Since the clearinghouse runs on the Internet, users do not have to install any software or hardware. The only requirement is that they have an Internet connection and a Web browser. The clearinghouse will store physician, pharmacy, and patient data according to the rules of HIPAA. The clearinghouse supports three types of customers - physicians, pharmacies, and patients. Patients are defined as any person that visits a physician and requires a prescription drug (Joao: abstract; col. 11, lines 65-67; col. 12, lines 1-67; col. 13, lines 1-7; col. 15, lines 17-25; col. 19, lines 12-21; col. 26, lines 44-67; col. 27, lines 1-8; Fig. 1).

Nevertheless, this feature is old and well known in the art, as evidenced by Joao. In particular, Joao discloses:

(a) the creation of a publicly accessible Internet-based electronic clearinghouse that processes prescriptions for drugs. Since the clearinghouse runs on the Internet, users do not have to install any software or hardware. The only requirement is that they have an Internet connection and a Web browser. The clearinghouse will store physician, pharmacy, and patient data according to the rules of HIPAA. The clearinghouse supports three types of customers - physicians, pharmacies, and patients. Patients are defined as any person that visits a physician and requires a prescription drug (Joao: abstract; col. 11, lines 65-67; col. 12, lines 1-67; col. 13, lines 1-7; col. 15, lines 17-25; col. 19, lines 12-21; col. 26, lines 44-67; col. 27, lines 1-8; Fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the teachings of Mayaud with the motivation of providing an apparatus and a method for processing and/or for providing healthcare-related information which can be utilized in a number of healthcare-related applications (Joao: col. 8, lines 3-7).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches a system for dispensing

drugs in health care institutions (4,847,764); prescription creation system (5,737,539); a medication monitoring system and apparatus (6,421,650); and a remote prescription refill system (6,493,427).

The cited but not applied prior art also includes non-patent literature articles by Menduno, Michael ("Apothecary.now" Jul 1999. Hospitals & Health Networks. Vol. 73, Iss. 7. pg. 34.); Business Wire ("ProxyMed Launches Web-Based Refill Authorization Service; Web Version of PreScribe Makes It Easy for Physician Offices to Get Off the Phone With Pharmacies" Feb 27, 2002. pg. 1.); and Singer, Glenn ("Getting Prescriptions Via Internet Offers Privacy, Poses Health Risks" Jul 22, 2002. Knight Ridder Tribune Business News. pg. 1.).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT 12.12.05

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER